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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/895,331      | 07/02/2001  | Eiji Satake          | 010860              | 6700             |

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141  
EXAMINER

GORR, RACHEL F

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1711

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/895,331

Applicant(s)

SATAKE ET AL.

Examiner

Rachel F. Gorr

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss and Rolando in view of Itabashi and Emmons.

3. Voss discloses dry laminate adhesives (see abstract) comprising a water-borne polyurethane resin, a polyisocyanate crosslinker (col. 3, last paragraph), and a thickener (col. 4, line 20). Voss discloses pigments and dispersing agents for pigments (col. 4, lines 21-22). In col.3, line 26, he states that he uses the polyurethane of Rolando. Rolando discloses an OH terminated polyurethane (see examples), which appears to have been prepared the same way and from the same ingredients as the applicant's examples. Voss and Rolando differ from the claims by not specifying the softening temperature and viscosity of the water-borne polyurethane, by not specifying an associative thickener and by not showing the pigment dispersing agent as a resin.

4. Emmons discloses polyurethane as associative thickeners (col. 7, lines 36-45), and he teaches that less thickener is needed if associative thickeners are used.

5. Itabashi discloses a water dispersible polyurethane pigment dispersing agent (see abstract, col. 2, lines 21-26).

6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the associative thickeners of Emmons in the adhesive of Voss in order to thicken the composition with a small amount of thickener. It would have

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been obvious to use the resin pigment dispersing agent of Itabashi in Voss's adhesive because Itabashi teaches using it for urethane formulations (col. 11, line 27), and Itabashi teaches improved pigment dispersibility (bottom col. 24). The softening temperature and viscosity of Rolando's water-borne polyurethane would be the same because the polyurethane appears to be the same as the applicant's.

7. Applicant's arguments filed 6-4-03 have been fully considered but they are not persuasive. The applicants argue that Rolando's softening temperature wouldn't be less than 50 deg. C because he dries at 50-85 deg., and one wouldn't dry above the softening temperature. The examiner argues that one would dry above the softening temperature to insure even film flow. In synthesis example 3, the applicants show a water-borne polyurethane that has too high a softening temperature. But this formulation is different from Rolando's examples. Rolando's examples are more like those of the invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel F. Gorr whose telephone number is 703-308-3608. The examiner can normally be reached on Mon., Tues., Thurs., Fri., from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

R.G.  
July 22, 2003

  
RACHEL GORR  
PRIMARY EXAMINER